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10/721,690	11/25/2003	Mary K. Kroening	59052US002	6171

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3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

JABR, FADEY S

ART UNIT PAPER NUMBER

3639

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,690	<b>Applicant(s)</b> KROENING, MARY K.	
	<b>Examiner</b> Fadey S. Jabr	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/3/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

Claims **1, 9, 13-15, 17-18 and 23** have been amended. Claims **1-26** remain pending and are again presented for examination.

### ***Response to Arguments***

1. Applicant's amendment filed 3 February 2006, with respect to the Objection of Claim 18, has been withdrawn due to Applicant's amendment.
2. Applicant's amendment filed 3 February 2006, with respect to rejections under 35 U.S.C. sections 112, second paragraph, has been withdrawn due to Applicant's amendment.
3. Applicant's arguments filed 3 February 2006, with respect to the rejection under 35 U.S.C. section 101, have been considered. However, the indicated claims are still non-statutory and therefore the rejection is upheld. Although the claim limitations result in procurement of the packaging material, the result is not tangible or concrete and therefore is not a practical application.
4. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim **15 and 16** rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per Claim **15 and 16**, these claims recite a series of steps and are considered for the purpose of analysis un 35 U.S.C. 101 as reciting a series of steps. The claims do not recite an pre- or post-computer activity but merely perform a series of steps of generating and implementing commodity profiles, and is directed to non-statutory subject matter. A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). Further, the claims merely manipulate an abstract idea (selecting, storing, generating and transmitting data) or perform a purely mathematical algorithm without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335,200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate

rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including, generating and implementing commodity profiles which are nothing more than product descriptions without any concrete and tangible result and are therefore deemed to be non-statutory. While these numbers may be concrete and/or tangible, there does not appear to be any useful result.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Damji, Pub. No. US2003/0200111 A1 in view of SMA/RT Idea for Packaging Material Procurement hereinafter referred to as SMA/RT.

As per **Claim 1**, Damji discloses a method comprising:

- maintaining packaging data with a centralized packaging data (CPD) management system, wherein the packaging data defines types of packaging materials for use within an enterprise, and includes specification data that defines one or more

characteristics for each of the types of packaging materials

(Para. 15-18; also see Figures 5 and 6); and

- generating a commodity profile for a selected one of the types of packaging materials, wherein the commodity profile includes at least one electronic report that correlates:  
(1) costs of packaging materials (2) with the one or more characteristics of the selected one of the types of packaging materials

(Para. 17-19 and 53; Claim 29; and see Figures 5 and 6).

Damji fails to disclose an enterprise having a plurality of business units that produce a plurality of different products at a plurality of different manufacturing facilities, and packaging material purchase by the plurality of business units at the plurality of manufacturing facilities for the plurality of different products. However, SMA/RT teaches a packaging material procurement system with a plurality of separate businesses units that produce a variety of products that utilize the system (Page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Damji and include allowing a plurality of business units to utilize the packaging material system as taught by SMA/RT, because it allows for the minimization of changeovers and conduct longer runs, with both buyers and sellers sharing in the cost reduction (Page 1).

As per **Claim 2**, Damji further discloses a method further comprising executing a computer-implemented process to automatically generate the commodity profile  
(Para. 34; Claim 29).

As per **Claim 3, 18 and 24**, Damji further discloses a method wherein the costs comprise enterprise-wide costs maintained by the CPD management system (Para 19 and 30).

As per **Claim 4**, Damji further discloses a method further comprising maintaining spend data with the CPD management system that specifies the costs for the packaging materials purchased by the enterprise (Para. 30, lines 16-21).

As per **Claim 5**, Damji further discloses a method wherein generating the commodity profile comprises automatically generating the commodity profile with the CPD management system based on the spend data and the packaging data (Para. 53; Claim 29; also see Figures 5 and 6).

As per **Claim 6**, Damji further discloses a method wherein automatically generating the commodity profile comprises invoking a report generation module of the CPD management system to automatically retrieve the specification data and the spend data for the selected one of the types of packaging materials, and automatically generate the electronic report of the commodity profile based on the retrieved specification data and the retrieved spend data for the selected one of the types of packaging materials (Para. 17-19, 29, 30 and 53-54; Claim 29; also see Figures 5 and 6).



As per **Claim 7**, Damji further discloses a method further comprising:

- accessing the CPD management system to retrieve the corresponding specification data and spend data for the selected the packaging material (Para. 15); and
  - manually generating the electronic report of the commodity profile based on the retrieved specification data and the retrieved spend data for the selected one of the types of packaging materials
- (Para. 17-19 and 53-54; Claim 29; also see Figures 5 and 6).

As per **Claim 8 and 22**, Damji further discloses a method wherein the one or more characteristics comprise attributes and specifications of the types of packaging material (Para 53; Claim 29; also see Figures 5 and 6).

As per **Claim 9**, Damji further discloses a method further comprising:

- generating supplier profiles for one or more suppliers of the packaging materials of the selected one of the types of packaging materials (Para. 19); and
- procurement of the packaging materials based on the commodity profile and the supplier profiles (Para. 17-19).

As per **Claim 10**, Damji further discloses a method wherein each supplier profile describes financial information for a respective one of the suppliers (Para. 19).

As per **Claim 11**, Damji further discloses a method wherein each of the supplier profiles describe a current supplier of the packaging materials to the enterprise or a candidate supplier that may be used for future procurement of the packaging materials (Para. 19).

As per **Claim 12**, Damji further discloses a method wherein each supplier profile describes strengths, weaknesses, opportunities, and threats for a respective one of the suppliers (Para. 15 and 19).

As per **Claim 13 and 14**, Damji further discloses a method further comprising:

- generating a market profile that identifies a current state of markets that affect the purchase of commodities by the enterprise (Para. 30);
- procurement of the packaging materials based on the commodity profile and the market profile (Para. 17-19 and 54, see also Figures 5 and 6).

As per **Claim 15**, Damji discloses a method comprising:

- generating a commodity profile for a type of packaging material, wherein the commodity profile describes a current state of consumption of the type of packaging material by an enterprise (Para. 17-19);
- generating a market profile that identifies a current state of one or more markets that affect the purchase of commodities by the enterprise (Para. 30);
- generating a supplier profile for one or more suppliers of packaging materials of the type of packaging material (Para. 30); and

- procurement of the packaging material based on the commodity profile, the market profile and the supplier profiles (Para. 17-19).

Damji fails to disclose an enterprise having a plurality of business units that produce a plurality of different products at a plurality of different manufacturing facilities. However, SMA/RT teaches a packaging material procurement system with a plurality of separate businesses units that produce a variety of products that utilize the system (Page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Damji and include allowing a plurality of business units to utilize the packaging material system as taught by SMA/RT, because it allows for the minimization of changeovers and conduct longer runs, with both buyers and sellers sharing in the cost reduction (Page 1).

As per **Claim 16**, Damji further discloses a method wherein the commodity profile identifies one or more characteristics of the type of packaging material, and includes at least one electronic report that associates respective enterprise-wide costs for procurement of the packaging materials of the type of packaging material with each of the characteristics of the type of packaging material (Para. 17-18 and 54; Claim 29; see also Figures 5 and 6).

As per **Claim 17**, Damji discloses a method comprising:

- a centralized packaging data (CPD) management system that stores packaging data that defines types of packaging materials used within an enterprise, and spend data that specifies costs for procurement of packaging materials of the defined types of packaging materials (Para. 15-18 and 30, see also Figures 5 and 6); and

- a reporting module executing on the CPD management system, wherein the reporting module generates an electronic report for a selected one of the types of packaging materials, wherein the electronic report associates respective portions of the costs of the spend data with the characteristics of the selected one of the types of packaging materials (Para. 17-19, 29, 30 and 53; Claim 29; see also Figures 5 and 6).

Damji fails to disclose an enterprise having a plurality of business units that produce a plurality of different products at a plurality of different manufacturing facilities. However, SMA/RT teaches a packaging material procurement system with a plurality of separate businesses units that produce a variety of products that utilize the system (Page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Damji and include allowing a plurality of business units to utilize the packaging material system as taught by SMA/RT, because it allows for the minimization of changeovers and conduct longer runs, with both buyers and sellers sharing in the cost reduction (Page 1).

As per **Claim 19**, Damji further discloses a method wherein the reporting module generates a commodity profile that includes the electronic report as one of a plurality of electronic reports based on the portion of the spend data and the selected one of the types of packaging materials (Para. 17-18 and 54; Claim 29; see also Figures 5 and 6).

As per **Claim 20**, Damji further discloses a method wherein CPD management system maintains the packaging data to include specification data that defines characteristics for each of the types of packaging materials, and further wherein the reporting module generates the

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electronic report to associate respective portions of the costs with the characteristics of the selected one of the types of packaging materials

(Para. 17-19 and 54; Claim 29; see also Figures 5 and 6).

As per **Claim 21**, Damji further discloses a method wherein the report generation module:

- accesses the specification data to identify the characteristics of the selected one of the types of packaging materials (Para. 18 and 19),
- retrieves the respective portions of the spend data corresponding to the identified characteristics (Para. 18 and 19), and
- generates the electronic report of the commodity profile based on the retrieved specification data and the retrieved spend data for the packaging materials of the selected one of the types of packaging materials (Para. 17-18 and 54; Claim 29; see also Figures 5 and 6).

As per **Claim 23**, Damji discloses a computer-readable medium comprising instructions that cause a processor to:

- access packaging data and spend data stored by a centralized packaging data (CPD) management system, wherein the packaging data identifies types of packaging materials for use within an enterprise and the spend data specifies costs for procurement of packaging materials of the identified types of packaging materials (Para. 17 and 18; Claim 29);

- receive input from a user selecting one of the types of packaging materials  
(Para. 17, lines 5 and 6); and
- generate an electronic report for a selected one of the packaging materials, wherein the electronic report associates a respective portion of the costs of the spend data with the characteristics of the selected one of the types of packaging materials  
(Para. 17-18 and 54; Claim 29).

Damji fails to disclose an enterprise having a plurality of business units that produce a plurality of different products at a plurality of different manufacturing facilities. However, SMA/RT teaches a packaging material procurement system with a plurality of separate businesses units that produce a variety of products that utilize the system (Page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Damji and include allowing a plurality of business units to utilize the packaging material system as taught by SMA/RT, because it allows for the minimization of changeovers

As per **Claim 25**, Damji further discloses a method wherein the instructions cause the processor to generate a commodity profile that includes the electronic report as one of a plurality of electronic reports based on the portion of the spend data and the selected one of the types of packaging materials (Para. 17-18 and 54; Claim 29; see also Figures 5 and 6).

As per **Claim 26**, Damji further discloses a method wherein CPD management system maintains the packaging data to include specification data that defines characteristics for each of the types of packaging materials, and further wherein instructions cause the processor to generate

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the electronic report to associate respective portions of the costs with the characteristics of the selected one of the types of packaging materials

(Para. 17-18 and 54; Claim 29; see also Figures 5 and 6).

### *Conclusion*

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Fadey S Jabr  
Examiner  
Art Unit 3639

FSJ

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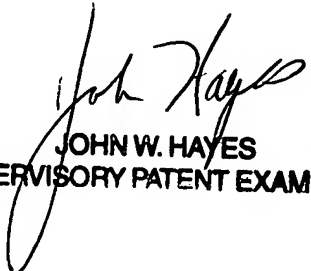
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**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**